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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,980	12/14/2001	Jeremy J. Nathanson	DJORTH.120A	2400

20995 7590 09/16/2003

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EXAMINER

MELSON, CANDICE C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 09/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,980

Applicant(s)

NATHANSON ET AL.

Examiner

Candice C. Melson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-28 and 33-36 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 29-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the slide first surface" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Incavo et al (USPN 5,827,286) in view of Nakajima (USPN 6,335,036). Incavo et al disclose "an internal osteotomy fixation device 2" comprising "a distal plate 4" including a channel. In particular, "the distal plate 4" has "a second end 14, with the second end having an opening that receives the slide 6" (column 4, lines 64-66). As shown in Fig. 4, "slide 6" is translatable with respect to the "distal plate 4" along a first axis and the "slide 6" has ratchet teeth on a first surface. "Ratchet arm 16" is fixed to "distal plate 4" and includes teeth configured to engage the

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slide ratchet teeth. "In one embodiment, the ratchet arm 16 will be a pawl and groove/tooth 25 type of device that will allow advancement of the slide 6 in a first direction but will preclude direction in the opposite movement so that the slide 6 can only be advanced and not retracted" (column 5, lines 3-9). Finally, the osteotomy device 2 also includes a "proximal plate 18".

Incavo et al does not disclose the proximal plate 18 hingedly connected to the slide 6.

Furthermore, as to Claims 1 and 2, Nakajima teaches a "bone adjuster 20" with "a first plate 22 attached to one of opposed bone fragments to be adjusted and a second plate 24 attached to the other" (column 3, lines 23-26). "The first plate 22 has a screw-in connecting portion 34 which has a screw hole for accepting the adjusting shaft 26. The screw-in connecting portion 34 is connected to the mounting plate 28 via a hinge 36 so to conform with various shapes of the skeletal frame to be adjusted, so that it is pivotable with the hinge 36 as an axis, enabling support of the adjusting shaft 26 at an appropriate angle" (column 3, lines 39-45). As to Claim 3 and 5, Incavo et al disclose "the slide 6, which is part of the proximal plate 18, contains a bend or curve, with the bend being an angle of deflection represented by the numeral 28. The angle of deflection 28 represents the general contour of the tibia. The angle of deflection may be varied depending on the particular contour of the patient's tibia" (column 5, lines 30-36). As a matter of obviousness, this bend or curve may also be present in the distal plate 4 in addition to or instead of the proximal plate 18. With respect to Claim 4, the distal plate comprises through-holes 10,12 and the proximal plate comprises through-holes 24,26 each adapted to receive a bone screw for securing the device to a patient's bone. As to Claim 6, as best shown in Fig. 1A, the ratchet arm 16 is disposed within a second channel in the posterior surface of the distal plate.

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Regarding Claim 7, Nakajima teaches the proximal plate includes a first portion 28 defining a first plane and a ledge 22 defining a second plane generally perpendicular to the first plane.

It would have been an obvious to one of ordinary skill in the art at the time the invention was made to incorporate the hinge feature as taught by Nakajima in order to provide a fixation device capable of adjusting to conform to various skeletal frames and thereby being capable of being used for a wider range of patients.

Allowable Subject Matter

Claims 9-28,33-36 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Melson whose telephone number is (703) 305-8128. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

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Candice Melson
August 25, 2003

Cary E. O'Connor
Cary E. O'Connor
Primary Examiner